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Docket No.: 239907US-2 DIV

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 10/625,679
Applicants: Hisao WATANABE
Filing Date: July 24, 2003
For: CLV OPTICAL DISC, CLV OPTICAL DISC FORMAT, AND AN OPTICAL DISC MEDIUM RECORDING AND REPRODUCING APPARATUS
Group Art Unit: 2653
Examiner: Vuong, B.Q.

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION

Our check in the amount of **- 0 -** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO: 239907US-2 DIV

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:
HISAO WATANABE	: EXAMINER: VUONG, B.Q.
SERIAL NO: 10/625,679	:
FILED: JULY 24, 2003	: GROUP ART UNIT: 2653
FOR: CLV OPTICAL DISC, CLV OPTICAL DISC FORMAT, AND AN OPTICAL DISC MEDIUM RECORDING...	:

PROVISONAL ELECTION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the communication dated September 27, 2004, and further in response to the Restriction Requirement contained therein, Applicants herein provisionally elect the invention of Group II, Claims 35-56 and 63-71, indicated in the Requirement to be drawn "to an optical disc master board."

In addition to making this provisional election, Applicants further respectfully traverse this Requirement for the reason that the inventions of Groups I and II have not been shown to be either independent and/or distinct as required by the Statute and the Rules.

The assertion of paragraph 2 at the top of page 2 of the Requirement that "[i]nventions I and II are unrelated" is not an authorized rationale for making a restriction requirement. In this regard, 35 U.S.C. §121 only provides authority to the Director to require restriction in an application claiming "two or more independent and distinct inventions." The Director cannot delegate any authority to make a restriction based on mere allegations that inventions are "unrelated" as the above-noted statute does not authorize the Director to

require restriction as between alleged "unrelated inventions." In addition, 37 CFR §1.141 and §1.142, the relevant rules of the PTO, also note that restrictions are to be made as between "two or more independent and distinct inventions," no authorization appears as to merely labeling groups of claims as being "unrelated" and then requiring an applicant to elect one of these groups with no explanation as to the reason the PTO is asserting these groups contain claims that can be said to be directed to "independent and distinct inventions."

Furthermore, MPEP §806.04 and MPEP §808.01, cited in the Requirement, are directed to explanations of what constitutes "independent inventions," not "unrelated inventions," and cannot be interpreted to provide PTO employees with powers not given to the Director.

Accordingly, as no authority exists that authorizes any PTO employee to make a Restriction Requirement based upon an assertion that two groups of claims are "unrelated," withdrawal of this improper Requirement is clearly in order.

Moreover, Applicant respectfully traverses the Restriction Requirement as failing to comply with the guidelines set forth in MPEP §803 that requires that:

> If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Here, a complete search of the provisionally elected claims will overlap the search areas for the non-elected claims. Accordingly, there will be no serious search and examination burden present here as to examining all pending claims together.

In light of the above noted improprieties, it is respectfully submitted that this Requirement should be withdrawn and that an action on the merits as to all of Claims 31-56 and 61-73 should be forthcoming.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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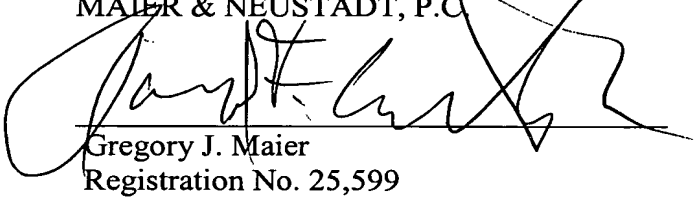

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